



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/491,865	01/27/2000	EIJI HAYASHI	35.C14206	9148

5514 7590 05/19/2004

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

PHAM, THIERRY L

ART UNIT PAPER NUMBER

2624

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/491,865

Applicant(s)

HAYASHI, EIJI

Examiner

Thierry L Pham

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

1. This action is responsive to the following communication: an Amendment filed on 3/8/04.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6574002 to Paczewitz, Paczewitz's admission of prior art (hereafter Paczewitz), and to U.S. Patent No. 6441924 to Matsui.

Regarding claim 1, Paczewitz discloses an information processing apparatus (computer, col. 3, line 46) for forming print data which can be interpreted by a printing apparatus (printer, Fig. 1) in accordance with document data formed by an application, comprising:

(1) setting means (print dialog settings box, fig. 2) for setting either the mail box mode ("Print to File" option allows the operators/users to save the documents onto the storage device, fig. 2) to accumulate the print data into a file (Print to file, Fig. 2, Paczewitz's admission of Prior Art) without printing it or a printer output mode (Fig. 2) to sequentially print the print data received by said printing apparatus; and

(2) forming means for forming said print data by adding information (Properties, Fig. 2) indicative of a destination (Print to file, Fig. 2) in said printing apparatus in accordance with the output mode set by said setting means.

(3) name designating means ("Print to File" option allows the operators/users to save the documents onto the storage device, and it is known in the art that if the operators/users select "print to file" option, another dialog box will appear denoting/asking the operators to enter name of that document and where to store it) for designating a document name of the print data;

Art Unit: 2624

and

(4) wherein the document name designated by said name designating means can be voluntarily designated via a user interface screen ("Print to File" option allows the operators/users to save the documents onto the storage device, and it is known in the art that if the operators/users select "print to file" option, an another dialog box will appear denoting/asking the operators to enter name of that document and where to store it) of said information processing apparatus.

The combinations of Paczewitz and Paczewitz's admission of prior art teach setting means for setting a mail box mode to accumulate the print data into a file, but does not expressly teach an information processing apparatus for forming accumulate print data to a "printing apparatus" without printing it and a printer apparatus comprising control panel for displaying the document name.

Matsui, in the same field of endeavor for information processing apparatus for forming print data, discloses a method to accumulate the print data into said printing apparatus (mail box within the facsimile apparatus, col. 2, lines 2-8 and lines 53-65 and Figs. 7 & 8) and a printer apparatus comprising control panel for displaying the document name (figs. 8-9).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Paczewitz's information processing apparatus for forming print data by the teachings of Matsui because of the following reasons: (1) to provide a method of automatically distributing received documents such that the received documents are quickly delivered to the right persons (Matsui, col. 1, lines 52-57); (2) storing print data in the memory of the printing apparatus, thereby, allowing users to print data at later time to reduce communication congestion of print buffer.

Regarding claim 2, Matsui further discloses an information processing apparatus for forming print data, further comprising: display control means (LCD panel, col. 5, lines 19-25) for, in the case where a mail-box-function of said printing apparatus cannot be used, displaying so as to make it possible to identify that a user interface (Fig. 8) to set the mail box mode by said setting means cannot be used.

Regarding claim 3, Matsui further discloses an information processing apparatus for forming

print data, further comprising: obtaining means for obtaining device information from said printing apparatus (a method of obtaining the device information indicative of the mailbox function, col. 3, lines 55-63,, and wherein display control means display and controls whether the user interface to set the mail box mode can be used or not on the basis of said obtained device information (a display control means for displaying whether a mailbox function can be used or not via a LCD display panel, col. 5, lines 19-33).

Regarding claim 4, Matsui further discloses an information processing apparatus for forming print data, further comprising box designating means (input device, col. 5, lines 22-23 and col. 6, lines 5-13) for designating to which one of a plurality of mail box areas (Fig. 8 & 9) in said printing apparatus said print data is outputted when a mail box output is performed, and wherein said box designating means displays a mail box list including a box number and a box name (Fig. 8 & 9) and designates on the basis of the device information obtained by said obtaining means.

Regarding claim 5, Matsui further discloses an information processing apparatus for forming print data, further comprising manual setting means for setting whether a mail box can be used or not on the user interface (user interface, Fig. 8) of a printer driver, and wherein said display control means (Fig. 8) displays and controls whether the user interface to set the mail box mode can be used or not on the basis of the setting by said manual setting means about whether the mail box can be used or not (col. 3, lines 26-49).

Regarding claim 6, Paczewitz further discloses an information processing apparatus for forming print data, wherein when the output mode is switched by said setting means, said display control means displays a message indicating that there is a change of the destination (Fig. 4). It would have been obvious to change a message of Fig. 4 by Paczewitz to display a message indicating that there is a change of the destination.

Regarding claim 7, Matsui further discloses an information processing apparatus for forming print data, further comprising name designating means (Fig. 8 & 9, col. 5, lines 19-32) is capable of designating a name of the print data to be transmitted to said printing apparatus when

Art Unit: 2624

the mail box mode is selected by said setting means.

Regarding claims 8-14: Claims 8-14 are the method claims corresponding to the apparatus claims 1-7 (respectively). The methods are inherent and included by the operation of the apparatus.. Please see claims rejection basis/rationale as described in claims 1-7 above.

Regarding claims 15-21: Claims 15-21 correspond to claim 1-7 except computer readable memory medium for storing program is claimed rather than printing system or data output apparatus. All computers have some type of computer readable memory medium (Memory, fig. 1, Matsui) for storing computer programs, hence claims 15-21 would be rejected using the same rationale as in claims 1-7.

Regarding claims 22-28: Claims 22-28 correspond to claim 1-7 except computer readable memory medium for storing program is claimed rather than printing system or data output apparatus. All computers have some type of computer readable memory medium (Memory, fig. 1, Matsui) for storing computer programs, hence claims 22-28 would be rejected using the same rationale as in claims 1-7.

Response to Arguments

4. Applicant's arguments, see page 12, lines 5-10, filed 3/8/04, with respect to claims 22-28 have been fully considered and are persuasive. The U.S.C. 101 rejection of claims 22-28 has been withdrawn.

Applicant's arguments filed 3/8/04 have been fully considered but they are not persuasive.

Regarding claim 1, the applicant argued the combination of Paczewitz and Matsui do not teach and/or suggest a name designating means for designating a document name of print data.

In Response: Paczewitz teaches a print dialog box of Fig. 2 comprising a "Print to File" option which allows the operators/users to save the documents onto the storage device, fig. 1, and it is known in the art that if the operators/users select "print to file" option, another dialog box will

Art Unit: 2624

appear denoting/asking the operators to enter the name of that document and where to store it. Please see claim rejection as described in claim 1 above for more details.

Regarding claim 1, the applicant argued Paczewitz does not teach the designated name is to be displayed on an operation panel of the printing apparatus.

In Response: The examiner will note that applicants are arguing subject matter not previously claimed in claim 1. Nowhere in claim 1 that applicants recite the nature of "designated name is to be displayed on an operation panel of the printing apparatus". However, Matsui teaches a printer's control panel which displays the document name via the control panel (figs. 8-9). See rejection/rationale as described in claim 1 for more details.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(1) U.S. 5859623 to Meyn et al, teaches an example of "Print to File" option which allows the operators/users to designate a document name and store it to a specific location (col. 11, lines 50-67 to col. 12, lines 1-5 and col. 13, lines 1-15).

(2) U.S. 6268927 to Lo et al, teaches an example of "Print to File" option which allows the operators/users to designate a document name and store it to a specific location such as sprinter's storage device (col. 7, lines 10-17).

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2624

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

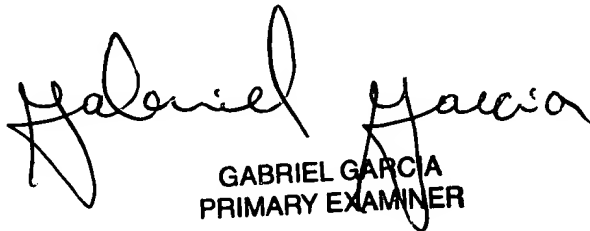
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L Pham whose telephone number is (703) 305-1897. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K Moore can be reached on (703)308-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham

TP


GABRIEL GARCIA
PRIMARY EXAMINER